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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/960,431 10/29/97 SUGIYAMA

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QM32/1009

EXAMINER

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ART UNIT PAPER NUMBER

15

3723

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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 15

Application Number: 08/960,431
Filing Date: October 29, 1997
Appellant(s): SUGIYAMA ET AL.

R. Lee Fraley
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 20, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-13 or 14-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Reissue Applications

Claims 1-13 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.* 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) related subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The limitations omitted in the reissue are "radial direction of", and "and perpendicular to the radial direction". These provides broadening aspect to the reissue claims that was clearly argued in the original application amendment filed on May 17, 1996 to overcome the rejection based on *Bombardier et al.*'021 in view of *JP*'870, *Beasley*'963, *Ruark et al.*'681, and *Holzhauser* filed on February 26, 1996. Thus, the

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omitted limitation relates to subject matter previously surrendered, in the original application.

Claims 14-21 are allowed.

(11) *Response to Argument*

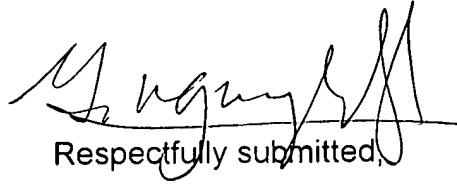
With reference to claims 14-21, the argument is moot because claims 14-21 are now allowed. The examiner inadvertently rejected claims 14-21 under the Doctrine of Recapture since these claims were never amended in the present reissue application. Regarding to Appellant's argument that in the absence of sufficient evidence, for example specific arguments in the prosecution history, that demonstrated an admission that the scope of the claims were not, in fact, patentable, mere amendments are insufficient to support the application of Doctrine of Recapture. The examiner disagrees because there is specific arguments on the prosecution history as found in the amendment of Paper No. 9 , page 4 for the method claims and page 6 for the apparatus claims.

Regarding to the proposal amended claims in Appendix B, the amendment will not be entered because it is not formally entered and there is no explanation how the amended claim would overcome the rejection under the Doctrine of Recapture.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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October 3, 2001

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